

REMARKS

Claims 1 and 8-12 were rejected under 35 U.S.C. § 102(b) as being anticipated by Ollivier *et al.* (U.S. Patent No. 6,385,492, "Ollivier"). Claims 3-4 were rejected under 35 U.S.C. § 103(a) as being rendered obvious in view of Ollivier.

I. 35 U.S.C. § 102(b) Rejection

Claims 1 and 8-12 were rejected under 35 U.S.C. § 102(b) as being anticipated by Ollivier. Applicants respectfully traverse the grounds for this rejection.

"[A] claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference." *Celeritas Techs., Ltd. v. Rockwell Int'l. Corp.*, 150 F.3d 1354, 1361, 47 U.S.P.Q.2d 1516, 1522 (Fed. Cir. 1998). The standard for lack of novelty, that is, for "anticipation," is one of strict identity. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1296, 63 U.S.P.Q.2d 1597, 1600 (Fed. Cir. 2002).

Claim 1 has been amended to include, among other things, that the "at least one relief formed on the cylindrical body, said relief having an overall helicoid contour and a continuous ridge of variable radius extending around and for a length along the cylindrical body." As Examiner indicated in an interview with undersigned counsel on July 16, 2008, Ollivier does not disclose or suggest a coronary probe head having a continuous ridge extending around the cylindrical body for a length along the body, with dimensions as required by claim 1 of the present invention. Instead, Ollivier shows, in Figs. 11-14, various specialized probe heads having specific structures as shown in the figures. Although the Examiner points to Fig. 12 of Ollivier as having a thread, Ollivier does not disclose a continuous ridge, as shown in Figs. 1 and 2 of the present invention. Indeed, none of the structures disclosed in Ollivier teach or suggest a

probe having a relief with a helicoid contour and continuous ridge of variable radius as taught in amended claim 1. As stated above, without either an express or inherent disclosure of this claimed functionality Ollivier cannot be anticipating prior art under 35 U.S.C. § 102.

For these reasons, the Applicants respectfully ask that the Examiner withdraw his rejections of claim 1, and claims 8-12 which depend from claim 1 and are allowable for at least the same reasons that claim 1 is allowable.

II. 35 U.S.C. § 103(a) Rejection

Claims 3-4 were rejected under 35 U.S.C. § 103(a) as being rendered obvious in view of Ollivier. Applicants respectfully traverse the grounds for this rejection.

The Supreme Court decision in *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350 (April 30, 2007) has done away with the rigid “teaching, suggestion, or motivation test” traditionally relied on to establish a *Prima Facie* case of obviousness. Instead of this rigid test, the Court has offered a “common sense” approach to making determinations of obviousness, stating that an initial inquiry should be “whether the improvement is more than just a predictable use of the prior-art elements according to their established functions.” *See KSR Int'l*, slip op. at p. 4. The Court also acknowledged that it is equally important to determine if there is an “apparent reason” to combine the references based on their “interrelated teachings.” *Id.* Finally, the Court also impliedly recognized that the prior art references, when combined, still must disclose all of the elements of the invention at issue for obviousness to be found. *Id.* at pp. 4-5.

As discussed above with respect to the Examiner's §102(b) rejections of Claims 1 and 8-12, Ollivier does not teach or suggest a coronary probe including "at least one relief formed on the cylindrical body, said relief having an overall helicoid contour and a continuous ridge of

PATENT

Attorney Docket No. 8707-2159

162 – Situs Excentre

Customer No.: 34313

Confirmation No.: 5782

variable radius extending around and for a length along the cylindrical body." *See supra*. For this reason, Ollivier does not disclose each and every element taught in claims 3 and 4.

Moreover, notwithstanding the holding in *KSR*, it is significant that Ollivier actually teaches away from the "continuous ridge," and instead discloses the use of "spheres" to wedge the probe into place. *See Ollivier*, Col. 7:14-16. *See In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997) (holding that a *prima facie* case of obviousness may also be rebutted by a showing that the art, in any material respect, teaches away from the claimed invention). *See also* MPEP, 8th Ed., at 2144.05. This "teaching away" from the present invention further establishes that the Applicants' invention is not a predictable use of prior art elements and is in fact a patentable contribution to the art.

For these reasons, the Applicants respectfully ask the Examiner to withdraw his rejections of claims 3 and 4 under 35 U.S.C. § 103(a).

PATENT

Attorney Docket No. 8707-2159

162 – Situs Excentre

Customer No.: 34313

Confirmation No.: 5782

CONCLUSION

Entry of the foregoing amendment, which is deemed to place this application in condition for allowance, and reconsideration of this application in view of the foregoing amendment and remarks respectfully is requested.

The Examiner is invited to call applicants' undersigned attorney if doing so would expedite prosecution.

Date: July 17, 2008

Respectfully submitted,

William B. Tabler, III
Registration No: 53,668
Attorney for Applicants
Phone No.: (212) 506-5284
Fax No.: (212) 506-5151

MAILING ADDRESS:

Orrick, Herrington & Sutcliffe LLP
IP Prosecution Department
4 Park Plaza, Suite 1600
Irvine, CA 92614-2558
Customer Number: 34313